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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/469,561 | 12/22/1999 | MARTIN PAGEL | 045923-P016U | 5104 |
| 29053 | 7590 | 02/06/2006 | EXAMINER | |
| DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. | | | WU, RUTAO | |
| 2200 ROSS AVENUE | | | ART UNIT | |
| SUITE 2800 | | | PAPER NUMBER | |
| DALLAS, TX 75201-2784 | | | 3639 | |

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/469,561 | | PAGEL, MARTIN | |
| | Examiner | | Art Unit | |
| | Rutao Wu | | 3639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 5, 17, 28, 36, and 41 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 14-16, 18-22, 23-27, 30--34, 37-39, 40, 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 11, 2005 has been entered.

Response to Arguments

2. Applicant's arguments, see page 1, filed October 14, 2005, with respect to claims 1-19, 21-22, 33-34 and 36-46 have been fully considered and are persuasive. The 35 U.S.C. 101 rejection of claims 1-19, 21-22, 33-34 and 36-46 has been withdrawn.
3. Applicant's arguments with respect to claims 1, 23 and 33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claim 1 is objected to because of the following informalities: "bits" is missing from the second and third claim limitation. Appropriate correction is required.

5. Claim 11 is objected to because of the following informalities: the term "and/or" is confusing, it is not clear if the applicant wants 'and' or 'or' Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim s 12-14 recites the limitation "said printer driver" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 23-27, 30, 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 5,873,073 to Bresnan et al.

Referring to claim 23:

A method of printing information on a printed document, said method comprising the steps of:

Sending a data stream to a printing device; (col 2: lines 33-36)

Reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents; (col 2: lines 25-29)

Maintaining in a secure memory an amount available for controlling the generation of a postage indicia; (col 18: lines 65-67)

Calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed; (col 7: lines 5-8)

Deducting said calculated postage amount from said secure memory if said calculated postage amount is available in said secure memory; and (col 2: lines 41-43)

Printing information from said data stream in accordance with said additional functions. (col 2: lines 23-25)

Referring to claim 24:

The method of claim 23 wherein said additional functions are selected from the list including printing address information, printing postage indicia, folding a printed document, stuffing a printed document into an envelope, creating a mailing address for the delivery of a printed document, creating a postage indicia, creating an auxiliary document in association with a printed document, controlling a second printer operating

in conjunction with said printer, verifying the address, normalizing the address, adding delivery bar codes. (col 2: lines 25-29)

Referring to claim 25:

The method of claim 23 wherein said reviewing step includes the step of:

Copying from said data stream portions of said data stream. (col 3: lines 60-68)

Referring to claim 26:

The method of claim 25 wherein said portions include address information with respect to a particular document to be printed. (col 2: lines 22-24)

Referring to claim 27:

The method of claim 26 further including the step of:

Creating from said copied address information a postage indicia. (col 7: lines 5-8)

Referring to claim 30:

The method of claim 25 wherein said portions include postage indicia information with respect to a particular document to be printed. (col 7: lines 5-8)

Referring to claim 31:

The method of claim 23 wherein said reviewing step includes the step of enabling a dialog box. (Fig 4)

Referring to claim 32:

The method of claim 31 wherein said dialog box interacts with a user to provide at least one of the following:

Return address and logo;

Data of mailing;

Address verification/prompt for insufficient information;
Review scanned data;
Hints for scanning data stream;
Additional cover page information or label/envelope customization;
Delivery (mail service, fax, e-mail, etc); and
Options (postage amount, paper weight, weight of inserts, additional mail services) (Fig 5A)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4, 6-13, 14-16, 18-22, 33-34, 37-39, 40, 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 5,628,249 to Cordery et al in view of U.S. Pat No. 5,873,073 to Bresnan et al.

As per claims 1 and 33: Cordery et al discloses abstracting at least a portion of said data bits from said data stream; (col 4: lines 25-29)

Cordery et al does not expressly disclose using at least some of said abstracted data for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia; and

Creating, from said abstracted data a separate data stream for controlling the printing of said postage indicia.

Bresnan et al disclose applying postage to the envelopes (col 7: lines 5-8)

Bresnan et al disclose in the invention the configuration and user interface of the system disclosed by Cordery et al, and also discloses the system can be further comprised of a number of elements which include: a meter linking device connected to a microprocessor; a weighing scale connected to the microprocessor; a postage meter connected to the meter linking device by an echoplex interface card. (col 18: lines 63-67)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery et al's invention to include postage printing feature. One would be motivated because Cordery et al discloses sealed envelopes output for franking with the proper postage, (col 5: lines 22-23) also, since Cordery et al's invention is capable of detecting and printing common elements of the address on the envelopes from the job data, (col 4: lines 33-34) it would be obvious postage indicia can be calculated and printed since all of the necessary elements are present in the system.

As per claims 2 and 34: Cordery et al disclose wherein said at least one additional function further comprises printing of address information on material separate from said printing information in accordance with said data stream. (col 4: lines 25-34)

As per claim 3: Cordery et al disclose wherein said at least one additional function further comprises printing of postage indicia on material separate from said printing information in accordance with said data stream. (col 4: lines 25-34; col 5: lines 22-23)

As per claim 4: Cordery et al does not expressly disclose at least one additional function further comprises a dialog box for allowing options from a user.

Bresnan et al does disclose dialog box for allowing options from a user (Fig 4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery et al's invention to include dialog box option disclosed by Bresnan et al. One would be motivated to perform such a modification to provide the user the ability to choose options.

As per claim 6: Cordery et al disclose at least one additional function further comprises directing the abstracted portion to multiple locations. (col 4: lines 25-34)

As per claim 7: Cordery et al disclose at least one additional function further comprises storage in a memory. (every computer device must have memory)

As per claim 8: Cordery et al disclose at least one additional function further comprises directing the abstracted portion to a viewable medium. (col 41-51)

As per claim 9: Cordery et al disclose at least one additional function further comprises the changing of form of the data (col 3: lines 53-57)

As per claim 10: Cordery et al disclose at least one additional function further comprises the delivery of said data to a location remote from said printer driver. (col 4: lines 25-34)

As per claim 11: Cordery et al disclose at least one additional function further comprises the change in location and/or format of the data based upon an interaction between certain data in said data stream and data stored in said printer driver. (col 4: lines 25-34)

As per claim 12: Cordery et al disclose printer driver is operable on said data stream coming from a program operating in a computing device to control at least a portion of the printing of said printer. (col 3: lines 41-52)

As per claims 13 and 38: Cordery et al disclose printer driver is located remote from said computing device. (Fig 3)

As per claims 14 and 39: Cordery et al does not expressly disclose that the printer driver is located within said printer.

Examiner submits that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the printer driver be within the printer. Cordery et al provides specific motivation from Fig 3 where the printer controller could be integrated with the print machine by the dotted lines.

As per claims 15 and 40: Cordery et al disclose wherein said abstracting includes: examining said data stream for preestablished data patterns (col 3: lines 55-57)

As per claim 16: Cordery et al disclose wherein said data patterns are selected from the list including:

Return address, destination address, mailing date, number of pages, type of inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes, graphics, application types. (col 3: lines 53-57)

As per claims 18 and 42: Cordery et al disclose printing of said postage indicia on a document other than the document to which said data stream is being directed. (col 5: lines 22-23)

As per claims 19 and 43: Cordery et al disclose wherein said preestablished data patterns include the beginning and ending of address information contained within said data stream. (col 3: lines 11-16)

As per claims 21 and 45: Cordery et al disclose wherein said preestablished data patterns include the beginning and ending of each document to be printed. (col 3: lines 11-16)

As per claim 22: Cordery et al disclose wherein said preestablished data patterns include the number of pages of a document. (col 2: lines 60-67)

As per claim 37: Cordery et al disclose wherein said computer product is operable on said data stream coming from a general purpose computing device. (col 3: lines 41-43)

As per claim 44: Cordery et al disclose wherein said computer product further contains a program for creating from said address information data for controlling the printing of a postage indicia. (col 3: lines 41-52)

As per claim 46: Cordery et al disclose wherein said data patterns are selected from the list including:

Return address, destination address, mailing date, number of pages, type of inserts, mailing service type. Postage indicia, bar codes, tracking codes, control codes.
(col 2: lines 60-67)

Allowable Subject Matter

13. Claims 5, 17, 28, 36, 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat No. 6,384,931 to Brown et al.

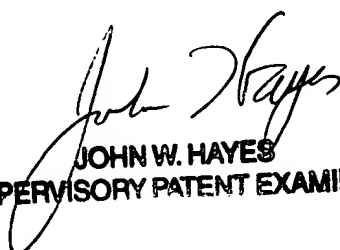
Art Unit: 3639

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rw


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER